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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,660	03/19/2001	Roman Efrain Vasquez Lipi	2119-109	9057

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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/02/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,660

Applicant(s)

VASQUEZ LIPI, ROMAN EFRAIN

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17, 18 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 18 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 4, 2002 has been entered.
2. Claims 1-15, 17, 18 and 22-27 are pending. No claims have been amended.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15, 17, 18, 22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,503,825 (825).

US '825 is directed to topical compositions that have healing properties. The compositions are particularly used for healing chapped, cracked, sunburned and windburned lips (abstract). The composition may comprise, as a vehicle, a mixture of any of mineral oil (liquid petroleum jelly excipient), vegetable oils such as castor oil, almond oil, olive oil and sunflower oil, animal oils such as cod liver oil, waxes such as beeswax and fatty acids, *inter alia* (col. 4, lines 18-53). Additional ingredients commonly

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used in the art that may be included in the composition of US '825 include preservatives (col. 4, lines 54-57).

US '825 does not explicitly teach a composition comprising all of the components instantly claimed, the particular amounts of each component (claims 2-5 and 10-15), vitamins A, D or E (claims 6-15) or stearic acid (claim 18). All of the instantly claimed components are well known and commonly used in the art. It is within the skill in the art to combine well-known and commonly used components expecting to obtain an art useful composition. Stearic acid is a common fatty acid that is naturally found in animal and vegetable fats and is commonly used in cosmetics and pharmaceuticals. See Hawley, The Condensed Chemical Dictionary, 10th Ed., Van Nostrand Reinhold Company, New York, (1981), page 968. A composition containing the vegetable and animal oils instantly claimed would be expected to contain stearic acid. Absent evidence of unexpected results, the particular combination of commonly used components is considered obvious in view of the prior art.

Applicant discloses in the specification at page 4, lines 23-25, that cod liver oil contains vitamins A and D and at page 5, lines 4-7, that sunflower oil contains vitamin E. Therefore, a composition containing cod liver oil and sunflower oil would also contain vitamins A, D and E. It is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, the amounts of ingredients are not considered critical to the invention. Absent evidence of unexpected results, the amounts of ingredients as instantly claimed are obvious in view of the prior art. Compositions

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containing the amounts of sunflower and cod liver oils as instantly claimed would be expected to contain the amounts of vitamins instantly claimed based on Applicants disclosure at pages 4 and 5 of the specification.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '825 using any desired combination of ingredients with the reasonable expectation of obtaining a topical composition with improved healing properties.

5. Claims 1-15, 17, 18, 22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,503,825 (825) in combination with US 4,386,067 (067).

US '825 discloses all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejection above. It does not explicitly teach that the oils and waxes are commonly used in the art.

US '067 discloses that oils commonly used in topical cosmetic compositions include sunflower, almond, olive, castor and fish-liver oils (col. 2, lines 39-51 and claims).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '825 using any combination of commonly used oils as disclosed in US '067 with the reasonable expectation of obtaining a topical composition with improved healing properties.

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,503,825 (825) alone or in combination with US 4,386,067 (067) as applied to claims 1-15, 17, 18, 22 and 24-27 above, and further in view of US 5,597,849 (849).

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US '825 and US '067 teach all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejections above. Neither reference teaches butylhydroxytoluene.

US '849 discloses a composition for topical use that comprise butylhydroxytoluene (BHT), which is an art-recognized preservative, (col. 8, lines 24-30 and the claims). The compositions may also contain beeswax, sunflower oil, mineral oil, castor oil, stearic acid (col. 9, lines 53-67, col. 7, lines 55-67, the examples and the claims). The amount of beeswax is about 15-17% of the composition (examples). The composition contains from about 1-40% oils of any combination (col. 9, lines 58-62).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '825 using butylhydroxytoluene as the preservative for its known preservative and antioxidant properties.

Response to Arguments

7. Applicant's arguments filed June 4, 2002 have been fully considered but they are not persuasive.

8. Applicant argues that US '825 does not teach a composition comprising a combination of all of the components instantly claimed. The rejection of the claims over US '825 above are based on obviousness under 35 U.S.C. 103. The basic criteria for establishing a prima facie case of obviousness are: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. See

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MPEP 2142. The prior art teaches that all of the components instantly claimed are common components of cosmetic compositions. It is known in the art to use various combinations of waxes and oils in cosmetic compositions. US '825 explicitly teaches mixtures of waxes and oils at column 4, line 53. One of ordinary skill in the art would have a reasonable expectation of success in using any combination of the disclosed common cosmetic components. One of ordinary skill in the art would be motivated to use any combination of the disclosed common cosmetic components in order to obtain the desired effect, in this case a topical composition with improved healing properties.

9. In response to applicant's argument that US '825 uses beeswax and oils as cosmetic vehicles and not as active agents, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Oily and waxy substances have been used throughout the ages for treating and healing various injuries. The prior art teaches that all of the components instantly claimed can be used in topical compositions used for healing chapped, cracked, sunburned and windburned lips.

10. Applicant argues that US '825 is directed to making lips feel smoother and moister as opposed to the treatment of injuries as instantly claimed. As stated above, the compositions of US '825 are topically applied to the lips for healing chapped, cracked, sunburned and windburned lips. It is the Examiner's position that chapped, cracked, sunburned and windburned lips are encompassed by injuries as instantly

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claimed. Therefore, US '825 teaches the treatment of injuries to the skin or mucosa by topical application of the compositions.

11. Applicant argues that the references do not recognized the criticality in the amount of beeswax in claims 3 and 25. Applicant has not provided any evidence of record to show criticality in the amount of beeswax. It is within the skill in the art to optimize ranges absent evidence of criticality. See MPEP 2144.05.

12. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

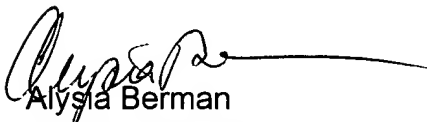
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
June 25, 2002


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